



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,117	08/28/2001	Vincent P. Robibero	132702-0114	3920

50659 7590 12/29/2005
BUTZEL LONG
DOCKETING DEPARTMENT
100 BLOOMFIELD HILLS PARKWAY
SUITE 200
BLOOMFIELD HILLS, MI 48304

EXAMINER

VAN BRAMER, JOHN W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/940,117	Applicant(s) ROBIBERO, VINCENT P.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>112801 080902</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, and 5-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 discloses a source of parametric data information, an equipment database, a product database, and an offer generator program that are present on an apparatus. The mere incorporation of data in a storage medium such as a database is considered non-functional descriptive material. (See MPEP 2106(IV)(B)1(b). Additionally, a program not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. (See MPEP 2106(IV)(B)1(a). Claims 5 -10 have similar deficiencies.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3622

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 discloses an apparatus that contains a source of parametric data information, an equipment database, a product database and an offer generator. However, the claim fails to particularly set out and circumscribe the apparatus with a reasonable degree of precision and particularity. An "apparatus" is claimed in the preamble, however no structure is recited in the body of the claim. Claims 2-10 inherit the deficiencies of independent claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-8, and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gronemeyer et al. (U.S. Patent Number: 6,363,359).

Claim 1: Gronemeyer discloses an apparatus for using data obtained from remote monitoring of equipment to generate product sales offers comprising:

- a. A source of parametric data information related to operating parameters of customer equipment. (Col 2, lines 41-57)
- b. An equipment database for receiving and storing said parametric data information. (Col 5, lines 47-67) (Gronemeyer references a log file in this section. The examiner has interpreted this, as presented in context, as a file of records relating to software and hardware on the consumers computer. A database is simply a large collection of organized data. As such, the log file as described is considered a database.)
- c. A product database for storing product information related to characteristics of a plurality of products related to the customer equipment, said product information for each said characteristic including a limit corresponding to a possible value of said parametric data information of an associated one of said operating parameters. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48) (In Col1, lines 29-46 Gronemeyer discloses that a product database and a cross-reference database are obvious improvements that have previously been made in the art. As such, in Col 5, lines 47-67, when the server is describes as having goods and wares separated into different categories that interact with a log file to generates sales offers it inherently contains such databases)
- d. An offer generator connected to said equipment database and to said product database for comparing a value of said stored parametric

data information of a selected one of said operating parameters with at least one of said stored product information limits corresponding to said selected one operating parameter, said offer generator generating a sales offer for a product associated with said limit directed to the customer associated with the customer equipment when said value and said limit have a predetermined relationship. (Col 5, line 47 through Col 6, line 48)

Claim 2: Gronemeyer discloses the apparatus according to claim 1 including a customer database connected to said offer generator for receiving said sales offer and a web server connected to said customer database for sending said sales offer to the customer. (Col 5, line 47 through Col 6, line 48)

Claim 3: Gronemeyer discloses the apparatus according to claim 2 wherein said web server generates said sales offer on a web page for viewing by the customer. (Col 4, lines 34-42)

Claim 5: Gronemeyer discloses the apparatus according to claim 1 including a customer database connected to said offer generator for receiving said sales offer, said customer database including customer information for verifying the accuracy of said sales offer. (Col 7, lines 56-64)

Claim 6: Gronemeyer discloses the apparatus according to claim 1 including a customer database connected to said offer generator for receiving said sales offer, said customer database including customer information for transmitting said sales offer to the customer. (Col 7, lines 56-64)

Art Unit: 3622

Claim 7: Gronemeyer discloses the apparatus according to claim 1 including an interface for receiving said parametric data information, a data collector connected to said equipment database and data transfer means connected between said interface and said data collector for transferring said parametric data information to said equipment database. (Col 2, lines 41-57)

Claim 8: Gronemeyer discloses the apparatus according to claim 1 wherein the products include devices and services. (Col 2, lines 41-57)

Claim 11: Gronemeyer discloses a method of using data obtained from remote monitoring of customer equipment to generate product sales offers, comprising the steps of:

- a. Receiving parametric data information related to an operating parameter of customer equipment. . (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)
- b. Storing the parametric data information in an equipment database. . (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)
- c. Storing in a product database product information related to a characteristic of at least one product including a limit corresponding to a possible value of the parametric data information. . (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)
- d. Comparing a value of the stored parametric data information with the limit. . (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

- e. Generating a sales offer directed to a customer associated with the customer equipment when the value and the limit have a predetermined relationship. . (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

Claim 12: Gronemeyer discloses the method according to claim 11 including a step of storing in a customer database customer information related to the customer and sending the sales offer to the customer based upon the stored customer information. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

Claim 13: Gronemeyer discloses the method according to claim 12 including sending the sales offer to the customer by at least one of regular mail, e-mail and a web page. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

Claim 14: Gronemeyer discloses the method according to claim 12 including using the customer information to verify the accuracy of the sales offer. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48) (Since the sales offer sent to the customer is based upon the customer information, the accuracy of the offer in relationship to the customer information is inherently verified)

Claim 15: Gronemeyer discloses the method according to claim 11 including a step of monitoring the customer equipment to generate the parametric data information. (Col 3, lines 11-37)

Art Unit: 3622

Claim 16: Gronemeyer discloses the method according to claim 11 wherein said step c. is performed by storing in the product database product information related to characteristics of a plurality of devices and services. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

Claim 17: Gronemeyer discloses the method according to claim 11 including performing said steps a. through b. for a plurality of operating parameters of the customer equipment. (Col 1, lines 29-46 and Col 5, line 47 through Col 6, line 48)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gronemeyer et al. (U.S. Patent Number: 6,363,359) in view of Palme et al (RFC 2557, MIME Encapsulation of Aggregate Documents, such as HTML).

Claim 4: Gronemeyer discloses the apparatus according to claim 2 wherein said web server generates said sales offer as a web page (Col 6, lines 35-48). However, Gronemeyer does not specifically state that the generated web page is transmitted to the consumer using an email transportation protocol. In the analogous teachings of Palme, a method of

encapsulating web pages in email documents is disclosed (Page 1, lines 18-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send the generated sales offers via email.

One would have been motivated to do so in order to provide potential customers with a reminder of the offer, in the event that the customer was not ready to make a purchasing decision during the browsing session.

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gronemeyer et al. (U.S. Patent Number: 6,363,359).

Claim 9: Gronemeyer discloses the apparatus according to claim 1 wherein data regarding the hard drive capacity and the maximum available storage are gathered in order to facilitate a decision by the system (Col 3, lines 11-37). While Gronemeyer does not specifically state that a threshold is used, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base this decision on a threshold. One would have been motivated to do so because the criteria supplied, hard drive capacity and available storage space, would readily lend themselves to calculating a percentage figure from which the threshold would be determined and a trigger point set. (i.e. Make offer if available storage space is less than 20% of the maximum capacity).

Claim 10: Gronemeyer discloses the apparatus according to claim 1 wherein data regarding the hard drive capacity and the maximum available

storage are gathered in order to facilitate a decision by the system (Col 3, lines 11-37). While Gronemeyer does not specifically state that a range is used, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base this decision on a range. One would have been motivated to do so because the criteria supplied, hard drive capacity and available storage space, would readily lend themselves to calculating a percentage figure from which a range would be established. Any percentage falling within this range would then trigger the generation of an offer. (i.e. Make offer if available storage space is between 5% and 20% of the maximum capacity).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Amado (U.S. Patent Number 5,537,590) which discloses an inventory management replenishment system which utilized network monitoring.
 - b. Dudle et al. (U.S. Patent Number: 5,570,291) which discloses a network enabled ,remote rules based data management system which is capable of being utilized for generating sales offers.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571)

Art Unit: 3622

272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb
December 7, 2005



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800